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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/004,485	11/02/2001	William P. Schenk JR.	99,316/1105.025	9408

7590 05/02/2005
Richard L. Sampson
50 Congress Street
Boston, MA 02109

EXAMINER

FITZGERALD, JOHN P

ART UNIT PAPER NUMBER

2856

DATE MAILED: 05/02/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

AK

Office Action Summary	Application No. 10/004,485	Applicant(s) SCHENK, WILLIAM P.	
	Examiner John P. Fitzgerald	Art Unit 2856	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-36 is/are pending in the application.
- 4a) Of the above claim(s) 5-14,30,31,34 and 35 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 36 is/are allowed.
- 6) ☒ Claim(s) 1-3,15-29,32 and 33 is/are rejected.
- 7) ☒ Claim(s) 4 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 02 November 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____. |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Response to Arguments

1. Applicant's arguments, see page, filed 07 February 2005, with respect to claims 4 and 36 have been fully considered and are persuasive. The previous rejection of claims 4 and 36 has been withdrawn.
2. Applicant's arguments with respect to claim 1 have been considered but are moot in view of the new ground(s) of rejection.

Allowable Subject Matter

3. Claim 36 is allowed over the Prior Art of record.
4. Claim 4 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.
5. The following is a statement of reasons for the indication of allowable subject matter: Objected claim 4 and allowed claim 36 contain allowable subject matter, in particular, tank-engageable leg portions being substantially equidistantly spaced from one another and collectively forming less than or equal to 50% of a notional periphery of the magnet mounting assembly. The Prior fails to teach this limitation, nor does it provide any type of motivation to alter the Prior Art to meet this limitation.

Claim Rejections - 35 USC § 103

6. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

7. Claim 1-3, 17-20, 24, 25, 28 and 29 are rejected under 35 U.S.C. § 103(a) as being unpatentable over US 4,390,309 to Fangmann. Fangmann discloses a magnet mounting assembly and method (Figs. 1-5) for use in detachably mounting a device (10) to a rounded ferromagnetic surface (60) of a pipe (note: a rounded, cylindrical surface of storage tank surface is an obvious equivalent of a rounded, cylindrical pipe surface (as recited in claims 17 and 18)) having: a ferromagnetic substantially flat (as recited in claim 2) support plate (see Fig. 2 below) including all of the recited elements with a permanent magnet (17) disposed on the interior face; a ferromagnetic plate extension (four in total, as recited in claims 4 and 36) (20, 21, 30, 40) disposed from the support plate and depending orthogonally relative to the support plate (as recited in claim 3) being sized and shaped with a plurality of axial heights (and thus directed the magnetic flux from the magnet, as recited in claims 25 and 29) (note adjustable means (32, 42 acting in slots to vary axial height) relative to the plate to form a plurality of legs having terminal/distal edges configured to engage the rounded ferromagnetic surface at a plurality of non-contiguous locations thereon (as recited in claims 1 and 36); wherein the legs depend adjustably from the support plate, however, may be held immovably (as recited in claim 1) via threaded machine screws (22, etc., see Fig. 3) cooperating with threaded boreholes (23, etc., see Fig. 3), thus allowing for proper “adjustment” of the support plates in contacting the rounded surface, thus, in effect, creating a “solid state device.” (as recited in claim 1). Furthermore, it would have been obvious to one having ordinary skill in the art to modify the magnet mounting

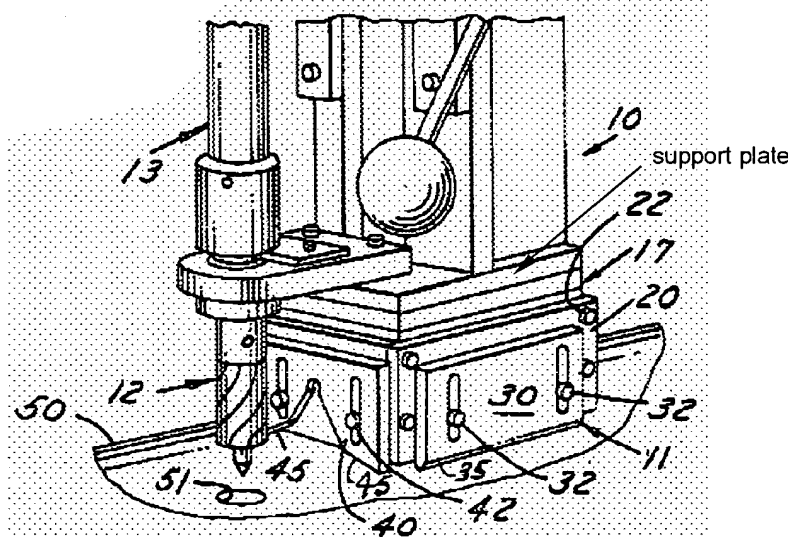
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assembly of Fangmann by making the legs integral with the support, since it has been held to be within the general skill of a worker in the art to make plural parts unitary as a matter of engineering design choice. *In re Larson*, 144 USPQ 347 (CCPA 1965); *In re Lockart* 90 USPQ 214 (CCPA 1951), for example, if the device was only to be employed on specific diameter pipes.

In specific regards to claims 17-19, Fangmann discloses V-shaped leg extensions for contacting the cylindrical surface of the pipe. Clearly if these V-shaped leg extensions were deployed on all sides, it would obviously engage a spherical surface. However, Applicant should note that functional recitation(s) using the words “for,” as in “for use in detachably mounting a device to a rounded ferromagnetic surface” cylindrical, spherical or otherwise, have been given little patentable weight because they fail to add any structural limitations and thereby regarded as intended use language. A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In the instant case, the assembly disclosed by Fangmann can easily be placed on a spherical surface without any modification. *In re Finstewalder*, 436 F.2d 1028, 168 USPQ 530 (CCPA 1971); *In re Casey*, 370 F.2d 576, 152 USPQ 235 (CCPA 1967) (“The manner or method in which such machine is to be utilized is not germane to the issue of patentability of the machine itself.”); *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). When interpreting functional language, if the prior art is capable of performing the claimed function—even if not directly disclosed—it anticipates. *In re Schreiber*, 128 F.3d 1473, 1478, 44 USPQ2d 1429, 1432 (Fed. Cir. 1997); *In re Sinex*, 309 F.2d 488, 135 USPQ 302 (CCPA 1962). See also MPEP § 2114, 2115. In specific regards to claim 20, the

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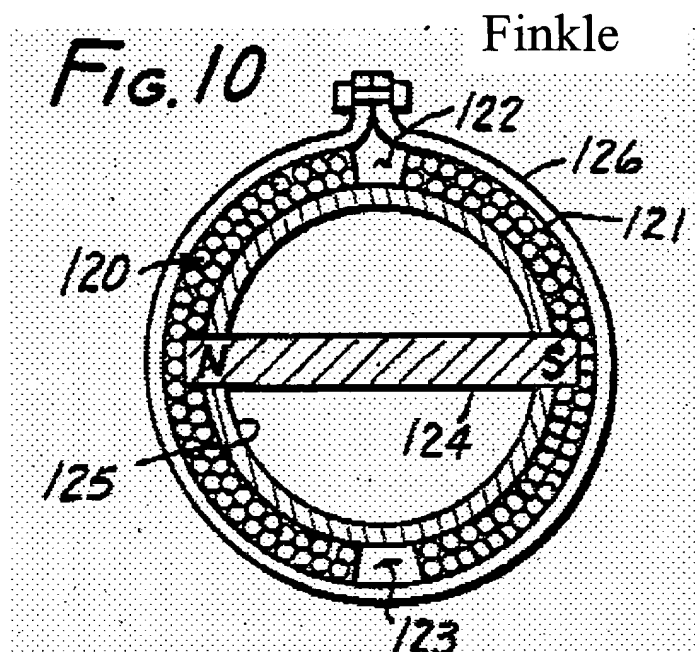
attaching/bonding of the magnet via adhesive or by any other well know method is considered to be a design choice based on desired strength of adhesion, and thus well within the design purview of one of ordinary skill in the art. In specific regards to claim 24, any ferromagnetic material (iron, nickel, cobalt, gadolinium, dysprosium and other rare earth metals) would function adequately and within the parameters of the instant invention and as such, considered as a design choice for one of ordinary skill in the art and all obvious substitutes. Lastly, specifically regarding method claim 28, the employment of the assembly and all of it's associated elements disclosed by Fangmann clearly meets all the method steps and limitations of the claim.

FIG. 2 Fangmann

8. Claims 15, 16, 21-23, 32 and 33 are rejected under 35 U.S.C. § 103(a) as being unpatentable over US 4,390,309 to Fangmann as applied to claim 1 above, and further in view of US 4,652,845 to Finkle. Fangmann discloses a magnetic mounting assembly having all of the elements and method steps recited previously including a rectangular shaped support plate and magnet (17) attached thereto. Fangmann does not expressly disclose a magnetic mounting

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assembly having a rounded or circular support plate (as recited in claims 15 and 16) or a correspondingly disc shaped ceramic magnet (note: any type of magnetic flux inducing material (ceramic, magnetized metals, electro-magnets, etc. are all obvious and well know equivalents to those of ordinary skill in the art) (as recited in claim 21); or alignment/mounting apertures with associative fasteners (as recited in claims 22, 23 and 32 and 33). Finkle teaches a magnetic mounting assembly (Figs. 1-11) for mounting gauges, indicators or other devices to non-planar surfaces (cylindrical, spherical, etc.) having a plurality of height adjustable leg extensions for non-contiguously contacting the non-planar surfaces; an alignment/mounting aperture (81) capable of receiving threaded fastener, and a specific embodiment (Fig. 11 below) that is substantially circular in a transverse plane to an axial direction. It would have been obvious to one of ordinary skill in the art at the time the invention was made to employ mounting/alignment apertures as well as forming the mounting assembly in a circular shape, as taught by Finkle, thus providing ease of mounting rounded dial gauges. Furthermore, the employment of any type of fastener (screws, bolts, rivets) within fastener/alignment holes/apertures to mount devices or objects to mounts or assemblies is considered to be all obvious variants well known to those of ordinary skill in the art.



9. Claims 26 and 27 are rejected under 35 U.S.C. § 103(a) as being unpatentable over US 4,390,309 to Fangmann as applied to claim 1 above, and further in view of WO 200054614 to Zollinger et al. Fangmann discloses a magnetic mounting assembly having all of the elements and method steps recited previously. Fangmann does not expressly disclose a magnetic mounting assembly having a non-sparking surface layer consisting of brass or stainless steel. Zollinger et al. teach the application of an anti-static, non-sparking coating to be applied to various components such as testing and inspection. It would have been obvious to one having ordinary skill in the art at the time the invention was made to employ a non-sparking surface layer on the magnetic mounting assembly for safe use in corrosive and explosive environments, i.e. if the storage vessel/tank on which the magnetic mount assembly is mounted is filled with explosive gases, vapors or liquids.

Conclusion

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to John Fitzgerald whose telephone number is (571) 272-2843. The examiner can normally be reached on Monday-Friday from 7:00 AM to 3:30 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hezron Williams, can be reached on (571) 272-2208. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you

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have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



JF

04/25/2005



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